

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Dean Furbush et al. Art Unit : 3695
Serial No. : 09/903,388 Examiner : Narayanswamy Subramanian
Filed : July 9, 2001 Conf. No. : 9349
Title : ORDER PROCESSING FOR AUTOMATED MARKET SYSTEM

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P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO WITHDRAW THE RESTRICTION REQUIREMENT MADE IN THE ACTION OF NOVEMBER 30, 2009

Applicant petitions pursuant to 37 C.F.R. 1.144 from the restriction requirement made November 30, 2009 and the final decision of the examiner in the action dated July 1, 2010.¹

The examiner required restriction as follows:

I. Claims 1-17 and 34-39, drawn to a system and method for trading of securities in an electronic trading venue, the method comprising entering at a client computing system an order executable against any participant that can at least in part satisfy the order, the client station including a display that renders a graphical user interface; choosing through the graphical user interface rendered on the display a priority type for how the order interacts with contra side quotes/orders in the trading venue classified in class 705, subclass 37. A utility of this group of claims is choosing through the graphical user interface rendered on the display a priority type for how the order interacts with contra side quotes/orders in the trading venue.

II. Claims 7-12 drawn to a computer program product and a system for an electronic trading venue for trading of securities, the computer program product comprising instructions for causing a computer to: receive an order entered from a client station, the order to buy or sell a specified quantity if a security, the order of a type that is executable for execution against any participant that can at least in part satisfy at least a portion of the specified quantity of the order; and determine from the received order a priority type for how the order interacts with contra side quotes/orders in the trading venue; and execute the order against contra-side interest according to the determined priority type, classified in class 705, subclass 37. A utility of this group of claims is executing the order against contra-side interest according to a determined priority type.

¹ Applicant notes the original withdrawal of the restriction in the action of March 13, 2008.

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Applicant elected Group I, claims 1-17 and 34-39, **WITH TRAVERSE.**² The original restriction requirement was erroneous on its face.³

In response to Applicant pointing this out the examiner furnished a communication on January 4, 2010 stating in part:

In the second paragraph of the restriction election mailed on November 23, 2009, there was an inadvertent error in the grouping of the claims. The second grouping should read:

II. Claims 29-33 and 46-49 drawn to a computer program product and a system for an electronic trading venue for trading of securities
Please note the correct grouping of claims as stated above.
The inadvertent error is regretted by the Examiner.

The examiner neither at that point nor in the earlier restriction otherwise furnished any reasons that Applicant could have respond to show the error in the examiner's reasoning.

The examiner in the latest office action⁴ neither removed the requirement nor indicated the requirement, as final. Rather, the examiner asked Applicant to cancel the traversed claims. Applicant treats the examiner's latest action as a **final action on the requirement** requiring Applicant to now petition.

In the latest office action, the examiner stated:

² Reply filed Dec 30, 2009

³ Action November 30, 2009

The Group I, claims 1-17 and 34-39, as originally presented, while not strictly drawn "to a system and method for trading of securities in an electronic trading venue" but were to "a system for an electronic venue for trading of securities." However, the reasons for subdividing out the Group II claims were clearly inaccurate. Contrary to the examiner's stated reasons "II. Claims 7-12 drawn to a computer program product and a system for an electronic trading venue for trading of securities" were not drawn to restrictable inventions. Claims 7-12 were drawn either directly or indirectly from the system of claim 1. These claims were not computer program product claims or a system different from claim 1, but are instead merely further limiting the scope of claim 1. In addition, the claims of Group II were already encompassed within Group I.

⁴ Action of July 1, 2010

Response to Arguments

9. In response to Applicant's arguments "Applicant however traverses because the examiner has not given any reasons why the groups are independent or distinct. The examiner also argued that: there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply. The examiner has not shown, that any of these reasons exist", the examiner respectfully disagrees. First of all, it is clear from the features of the two inventions that they are independent and distinct. Furthermore they have different utilites. A utility of claims 1-17 and 34-39 is choosing through the graphical user interface rendered on the display a priority type for how the order interacts with contra side quotes/orders in the trading venue, whereas utility of claims 29-33 and 40-49 is executing the order against contra-side interest according to a determined priority type. Secondly these inventions require different search strategies and search terms. The inventions require a different field of search (for example, searching electronic resources and employing different search queries) and the prior art applicable to one invention would not likely be applicable to another invention. For these reasons the restriction between the two inventions is maintained by the examiner.

While providing Applicant some guidance, the foregoing does not provide a sustainable basis for the examiner's restriction.

Applicant contends that the requirement is defective and improper. Claim 29 calls for:

29. A computer program product for an electronic trading venue for trading of securities said computer program product tangibly embodied on a computer readable storage medium comprising instructions for causing a computer to:
receive an order entered from a client station, the order to buy or sell a specified quantity of a security, the order of a type that is executable against any participant that can at least in part satisfy at least a portion of the specified quantity of the order; and

determine from the received order, a priority type for how the order interacts with contra side quotes/orders in the trading venue; and

execute the order against contra-side interest according to the determined priority type.

This claim specifies instructions performed by a computer that is processing an order, which allows selection of a priority type as in claim 1, namely, "... to choose a priority type for how the order interacts with contra side quotes/orders in the trading venue." Thus, the distinctions between claim 29 and claim 1 are where the functions recited in each of the claims are performed. The inclusion of the instructions to execute the order derive its novelty from the forgoing feature of to choose a priority type

In addition, the examiner had argued that "The inventions are distinct, from each other because "**The inventions are related as subcombinations disclosed as usable together in a single combination.**" The examiner has not shown claim 29 to be a subcombination of claim 1.

The examiner also stated that "**Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above**" Applicant contends that the examiner still has not given any reasons why the groups are independent or distinct.⁵ The examiner in the supplement remarks merely stated a conclusion that: "**First of all it is clear from the features of the two inventions that they are independent and distinct.**" This conclusion is not a reason or a rationale that can be used to prove the examiner's case.

The examiner now supplements the restriction arguing that the groups have different utilities. While it is true that group I is focused on choosing through the GUI the priority type and Group II receives an order entered from a client station, and determines from the received order, a priority type for how the order interacts with contra side quotes/orders in the trading venue, these claims do not recite separate utilities but merely different aspects of the invention. The mere fact that Group II also includes executing the order does not give Group II a different utility from Group I because executing orders is also a utility of group I, i.e., (A system for an electronic venue for trading of securities).

⁵ Applicant does not concede that the examiner must merely show one or the other, but rather it is Applicant's contention that the examiner must show both.

The examiner also argued that: “**... there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:**” The examiner has not shown that any of these reasons exist. Indeed, it is Applicant’s contention that where the examiner to find art that anticipated or rendered obvious one of the groups, which the examiner has yet to produce, that art would likely be applicable to the other group.

The examiner advanced the following reasons, which Applicant responds to as follows:

Reason 1:

(a) the inventions have acquired a separate status in the art in view of their different classification;

The examiner has not shown that they have different classifications. In fact the examiner admits that they have the same classification “**705, subclass 37.**”

Reason 2:

(b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;

The examiner has not shown that they have acquired a separate status or that there is divergent subject matter.

Reason 3:

(c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

The examiner has not shown that the groups would require a different field of search, different classes/subclasses or search queries. Indeed, Applicant contends that the subject matter of each of the groups would have the same field of search, classes/subclasses and the same or nearly the same search queries.

Reason 4:

(d) the prior art applicable to one invention would not likely be applicable to another invention;

The examiner has not shown that the prior art applicable to Group I would not also be applicable to Group II. This is borne out by the examiner's use of the same prior art against these claims previously.

Reason 5:

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

The examiner has not shown that the groups would raise different non-prior art rejections, e.g., under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph. Indeed, the subject of the groups would necessitate similar 101 and 112 issues were such issues been present, because each group is directed to computer-implementations that not are not subject to an analysis as being directed to manual or mental processes.

Applicant notes that were two separate patents to issue, one directed to Group I and the other directed to Group II, a party practicing one of the inventions of Group I or Group II could be subjected to harassment from two different patents that could have bifurcated ownership for what are essentially aspects of the invention expressed from two different viewpoints.⁶

Applicant has distinctly and specifically point out errors in the restriction requirement, in so far as the restriction can be understood and policy reasons as to why the restriction should not be maintained. Applicant therefore respectfully requests that the restriction requirement be removed.

Please apply the petition fee and any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: December 1, 2010

/Denis G. Maloney/
Denis G. Maloney
Reg. No. 29,670

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (877) 769-7945

⁶ Applicant does not imply that one of the groups is anticipated or obvious over the other group.